



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 09/830,415

Applicant: INAGAKI et al.

Filed: August 3, 2001

TC/AU: 3714

Examiner: C. Coburn

Docket No.: 401181

Customer No.: 23548

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request pre-appeal brief review of the final rejection of the patent application identified above. No amendments are being filed with this Request and the Request is being filed simultaneously with a Notice of Appeal. This Request is no more than five pages in length. Review is requested for the reasons stated on the following pages.

Claims 1, 2, 7-9, 11-15, 17-19, 22-25, 27-33, and 35-44 are pending in this application. Claims 1, 11, 12, 17, 22, 23, 31, 33, 35, 39, 43, and 44 are all independent claims.

In the Office Action mailed September 29, 2005, finally rejecting all pending claims, only the following rejections were made.

Claims 1, 2, 7-9, 11, 18, 19, 23-25, 27-32, and 44 were rejected as unpatentable over Ugawa (Published Japanese Patent Application 9-56896) in view of Kodachi et al. (U.S. Patent 6,142,875, hereinafter Kodachi).

Claims 12-15, 17, 22, 33, and 35-43 were rejected as unpatentable over Ugawa in view of Fuchs (U.S. Patent 5,630,753), and further in view of Kodachi.

Kodachi is critical to the rejections of all claims. However, pursuant to 35 USC 103(c), Kodachi cannot be used as prior art against the present patent application. Therefore, each of the rejections is legally defective. There is no need to consider any factual issue regarding the invention claimed to determine that all outstanding rejections should be withdrawn. Therefore, Appellants respectfully request Pre-Appeal Brief Review of the final rejection.

Kodachi is assigned of record to Aruze Corporation of Tokyo, Japan at reel 010318, frame 0960 of the assignments records of the United States Patent and Trademark Office. The present patent application is also assigned of record to Aruze Corporation at reel 012042, frame 0156 of the assignment records of the United States Patent and Trademark Office.

The present patent application is a national phase application of an international patent application, PCT/JP00/05693 filed in Japan on August 24, 2000. Thus, initially, the effective filing date of the present patent application is August 24, 2000, because the international application designated the United States. Moreover, the international application claimed the priority of the two Japanese national patent applications filed in Japan on August 31, 1999. With the Amendment filed January 6, 2004 in the prosecution of this patent application, Appellants submitted certified English language translations of their Japanese national patent applications 11-244279 and 11-244280, perfecting, pursuant to 37 CFR 1.55(a) (4)(i)(B), their priority claim. Thus, the Japanese filing date

of August 31, 1999, is the effective filing date of the present patent application provided the Japanese national patent applications support the pending claims.

The necessary support for the claims now pending is provided by the Japanese national patent applications. Attention is directed to pages 33-45 and Figures 19, 24, 27, 28, and 30-35 of the certified English language translation of Japanese patent application 11-244279 filed January 6, 2004 in the present patent application. These pages correspond to or are identical to original pages 30-39 and to Figures 20, 25, 28, 29, and 31-36 of the original U.S. patent application (a substitute specification was filed, but is not referred to here). These passages and figures clearly support the claim amendments that resulted in the citation of Kodachi. These passages, and the remainder of the two Japanese national patent applications, demonstrate that Appellants are entitled, pursuant to U.S. law, to claim and rely on their Japanese filing date of August 31, 1999 as the effect filing date of the present patent application.

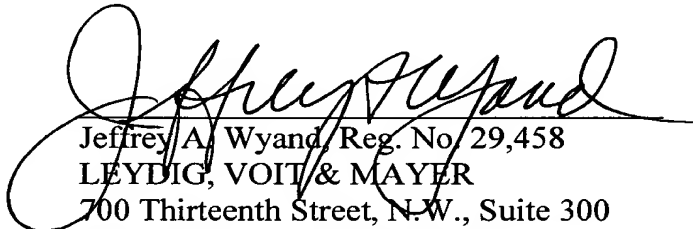
Kodachi issued as a U.S. patent on November 7, 2000 with a U.S. filing date of May 25, 1999. Kodachi cannot be prior art to the present application pursuant to 35 U.S.C. 102(a) because Kodachi was neither patented nor a printed publication in this or a foreign country before August 31, 1999, the effective filing date of the present patent application. It is even more apparent that Kodachi cannot be prior art to the present patent application pursuant to 35 U.S.C. 102(b). Kodachi was not filed more than one year before the effective filing date of the present patent application. The only subsection under which Kodachi can be prior art to the present patent application is 35 U.S.C. 102(e).

Since both Kodachi and the present patent application are assigned to Aruze Corporation, 35 U.S.C. 103(c) applies. That subsection provides that prior art that is only prior art under one or more of 102(e), 102(f), and 102(g) does not preclude patentability if the prior art and the claimed invention, at the time the invention was made, are commonly owned or subject to assignment to a common owner. It has just been demonstrated that Kodachi can only be prior art pursuant to 35 USC 102(e). The common assignment of Kodachi and the present parent application show that the second requirement of 35 USC 103(c) is met. Since every requirement of 35 USC 103(c) is fulfilled here, the use of

Kodachi to reject any claim of the present patent application is legally prohibited. Therefore, the prior art rejections based upon Kodachi are legally defective.

Since the rejections based on Kodachi are the only rejections, these rejections must be withdrawn. Upon the withdrawal of the rejections, claims 1, 2, 7-9, 11-15, 17-19, 22-25, 27-33, and 35-44 must be allowed, bringing to an end the extended prosecution of this patent application. Appellants therefore request that, upon conclusion of the pre-brief review, a Notice of Allowance be issued.

Respectfully submitted,


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JAW:jj

December 21, 2005